

REMARKS

This application has been carefully reviewed in light of the Office Action dated December 3, 2008. Claims 1 to 18, 20 to 37, 39 to 56 and 58 to 75 are in the application, of which Claims 1, 20, 39 and 58 are independent. Reconsideration and further examination are respectfully requested.

Page 2 of the Office Action provides a list of claims that are "pending", but the list provided in the Office Action is incorrect. As indicated above, the pending claims are 1 to 18, 20 to 37, 39 to 56 and 58 to 75. It is true that some of these claims have been withdrawn from further prosecution on the merits. Nevertheless, the non-elected claims remain pending in this case. The non-elected claims, which remain pending but have been withdrawn from further consideration, are signified above with the parenthetical caption of "withdrawn".

Further in this regard, all of the claims that have been withdrawn are dependent claims, and it remains Applicants' view that the independent claims herein are generic. In addition, the Examiner has agreed that at least Claim 1 is generic. Accordingly, once allowable subject matter has been indicated in the independent claims, it is respectfully requested for the Examiner to rejoin the withdrawn claims. See MPEP § 821, *et. seq.*

Moreover, insofar as can be determined, the Office Action provides an incorrect list of claims that have been elected for prosecution on the merits. The list of claims that have been elected for prosecution on the merits, together with claims that

already have been rejoined by the Examiner herein, is Claims 1 to 7, 13 to 18, 20 to 26, 29, 32 to 35, 37, 39 to 45, 48, 51 to 56, 58 to 64, 67 and 70 to 74. This list differs from that given in the Office Action by the inclusion of Claims 37 and 56. Both of these claims have been rejoined by the Examiner, as indicated at pages 9 and 10 of the Office Action.

Turning to the rejections entered in the Office Action, all claims currently under consideration were rejected based on art, primarily over U.S. Patent 5,625,758 (Schneider). The following claims were rejected under 35 U.S.C. § 102(e) over Schneider: Claims 1 to 7, 13 to 15, 20 to 26, 29, 32 to 35, 39 to 45, 48, 51 to 55, 58 to 64, 67 and 70 to 74. The following claims were rejected under § 103(a) over Schneider: Claims 18, 37 and 56. The following Claims were rejected under 35 U.S.C. § 103(a) over Schneider in view of U.S. Patent 5,699,450 (Stearns): Claims 16 and 17.

Reconsideration and withdrawal of these rejections are respectfully requested, as explained in more detail below.

The rejected claims concern the arrangement of print data according to a layout for the print data, wherein the print data is printed by a printer onto a recording medium, and in which the recording medium is thereafter processed by a target device. The target device is different from the printer. In example embodiments described in the specification, for example, the printer is a color laser printer, whereas the target device might be a color measuring device or an automatic sheet folder or binder.

Against this background, the claims are directed to an arrangement in which the printable areas on the recording medium are based on commonality between two different types of areas: valid areas and printable areas. Valid areas are areas on the

recording medium on which the printer can print. Printable areas are areas on the recording medium for which the target device has processing capabilities for processing properly.

As an example, when the target device is a color measuring device (as in the first embodiment), then the printable areas that are processed properly are those areas in which color patches must be printed by the printer in order to be processed by the color measuring device. As another example, when the target device is an automatic sheet folder or an automatic binder (as in the second embodiment), then the printable areas that are processed properly are those areas not hidden by being folded or bound.

As set out in more detail in the claims herein, there are three different determinations, which ultimately result in the determination of a layout for the print data, followed by an arrangement of the print data for printout by the printer in accordance with the determined layout. A first determination determines printing capabilities of the printer, wherein the printing capabilities include a designation of a valid area on the recording medium on which the printer can print. A second determination determines processing capabilities of the target device, wherein the processing capabilities include a designation of a printable area on the recording medium for which the target device has processing capabilities for processing properly. A third determination determines layout of the print data based on compatible capabilities between the printing capabilities of the printer and the printing capabilities of the target device. The layout is characterized by an area on the recording medium that is common between the valid area designated by the printing capabilities, and a printable area designated by the processing capabilities that is properly

processable by the target device. As mentioned above, following determination of the layout of the print data, the print data is arranged for printout by the printer in accordance with the determined layout.

The applied art is not seen to disclose or to suggest the foregoing arrangement, as set out in the claims herein. With respect to the Schneider patent, the USPTO has focused on the folding and/or cutting device described therein. According to the USPTO, the folding and/or cutting device of Schneider is seen to correspond to the claimed "target device different from the printer".

Schneider has been studied carefully, but only two mentions of his folding and/or cutting device can be found. A first mention is at column 4, lines 41 to 53, and a second mention is found almost immediately thereafter, at column 5, lines 9 to 18. In particular, Schneider states the following:

"When a product is based on a determined imposition layout,
the number of colors on a page is determined by the production
possibilities of the devices or machines, in particular the folding apparatus."
(Column 4, lines 43 to 46, emphasis added.)

Based on Schneider's description of his folding and/or cutting device, Applicants' understanding of Schneider is somewhat different than that of the USPTO. As Schneider is understood, it is only the number of colors on a page that is determined based on the fact that a folding machine is used. This differs from the claimed arrangement. According to the claimed arrangement, there is a determination of two different types of areas, namely, a valid area on the recoding medium on which the printer can print, and a

printable area on the recoding medium for which the target device has processing capabilities for processing properly. In contrast, as understood from Schneider, Schneider does not make determinations of any areas, of any type. More precisely, Schneider only determines the number of colors on a page.

In keeping with this deficiency of Schneider, the claims herein have been amended so as to emphasize that the layout for print data is determined based on commonality between a valid area designated for the printer, and a printable area designated as properly processable by the target device.

Stearns has been reviewed, but is not seen to add anything to the aforementioned deficiencies of Schneider.

It is therefore respectfully submitted that the claims herein recite subject matter that would not have been obvious to those of ordinary skill in the art, and allowance is respectfully requested.

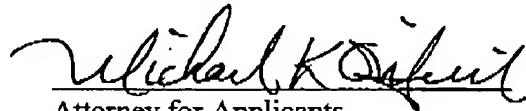
In addition, and as indicated above, rejoinder is respectfully requested for claims that have been withdrawn from prosecution on the merits.

**RECEIVED
CENTRAL FAX CENTER**

MAR 02 2009

Applicants' undersigned attorney may be reached in our Costa Mesa,
California office at (714) 540-8700. All correspondence should continue to be directed to
our below-listed address.

Respectfully submitted,



Attorney for Applicants
Michael K. O'Neill
Registration No.: 32,622

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

FCHS_WS 2897136v1